

**Remarks/Arguments:**

The specification is amended by inserting the corresponding sequence identifier adjacent to the sequence "LPXTG" and, thereby, comply with the sequence requirements set forth in the final Office Action.

Claims 15-24 and 26-29 are pending.

Claims 1-14 and 25 are canceled, without prejudice or disclaimer.

The claims are amended, hereby, to more clearly define the invention.

Claim 15 is amended by adding—at the end of the "correlation" step—"to thereby identify the active substances that affect the covalent bonding of the polypeptides" and, so, reflect the purpose—recited in the claim preamble—in the body of the claim. Accordingly, claim 15 now expressly recites what was otherwise inherently recited in the claim.

Claim 16 is amended by correcting the misspelling "emzymatic," i.e., to "enzymatic".

Claim 17 is amended to read:

The method according to claim 15, characterized in that said covalent bonding of polypeptides to the surface of the bacteria is effected by the polypeptides covalently bonding to murein present on the bacteria cell wall.

Antecedent basis is, thereby, clearly established for "murein" and "cell wall."

Claim 19 is amended by correcting, syntactically, "bacterial" to "bacteria."

Claim 20 is amended to include the claim dependency, inadvertently omitted when the claim was first presented.

Claim 21 is amended by inserting the corresponding sequence identifier adjacent to the sequence "LPXTG" and, thereby, comply with the sequence requirements set forth in the final Office Action.

Claim 23 is amended by replacing the adverb "vice versa"—meaning "the other way around"—with the actual other way around, itself. Instead of "vice versa" claim 23 now recites "from an active to an inactive conformation," i.e., the actual other way around of the recited "from an inactive to an active conformation."

Claims 16, 17, 19, and 20 were objected to and—based on issues related to those raised in the claim objections—claims 15-29 were rejected under 35 USC 112, 2<sup>nd</sup> ¶, for allegedly being indefinite. Reconsideration of the objection and the rejection is requested, in view of the present amendments to the claims.

The present amendments to the claims, as they are explained above, resolve all the issues raised in the claim objections and the rejection under §112, ¶2. Accordingly, the objections and rejection are overcome and, so, withdrawal of the objections and rejection appear to be in order.

Claims 15, 16, 20, 24-26, and 29 were rejected under 35 USC 102(b) as being allegedly anticipated by Samuelson. Claims 18, 19, 21, 27, and 28 were rejected under 35 USC 103(a) as allegedly unpatentable over Samuelson in view of Schneewind. Claims 22 and 23 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Samuelson in view of Schneewind in further view of Strauss. Reconsideration of the rejections is requested.

First of all, the rejections cannot be maintained for the same reasons/arguments set forth in the amendment filed on January 28, 2002, which reasons are expressly incorporated herein by

reference. The Response to Arguments—for each rejection—in the final Office Action relies on an incorrect interpretation of the rejected claims to support/maintain the rejections.

The PTO maintains the rejections because limitations distinguishing the cited references are recited in the preamble of the claims and, so, "has not been given patentable weight" (Office Action, page 7). This reasoning shows that the PTO failed to apply the proper standards for interpreting claims in a patentability analysis.

A preamble limitation on *use* encompasses *material limits on claim scope* in addition to the limitations recited in the body of the claim. *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 9 USPQ2d 1962 (Fed. Cir. 1989). The recitation of purpose in a claim preamble can limit the claim so as to define over the prior art. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). When the "purpose is included in the claims it serves as a limitation on the claimed intention and should be met literally or equivalently" by the prior art. *See, Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc.*, 40 USPQ2d 1481, 1489 (Fed. Cir. 1996).

The rejected claims include a recitation of purpose in the claim preamble, which is a limitation on the claims not found in the cited references, rendering the claims patentable over the cited references. *Stencel, supra*. The PTO admits that the process steps cannot stand alone, i.e., without the goal of "identifying active substances" recited in the claim preamble, since the PTO rejects the claims—as indefinite under §112, ¶2—because "the goal of the preamble is not commensurate with the steps of the method" (Office Action, page 3). This admission is not negated, moreover, by the apparently contradictory statement by the PTO in the Office Action (in the sentence bridging pages 7 and 8).

In any event, however, the present (amended) claims do affirmatively recite the preamble goal at the end claim. Therefore, no longer is "the goal of the preamble . . . not commensurate with the steps of the method." Moreover, the limitation distinguishing the claims over the cited references now constitutes "patentable weight" according to the PTO's own analysis.

Samuelson simply does not disclose a method limited to "identify the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria," in the manner presently claimed. Samuelson is directed entirely to methods and products for displaying heterologous proteins on the surface of *Staphylococcus carnosus*. There is absolutely no teaching or suggestion of a method involving "identify[ing] the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria," as presently claimed. Samuelson does not recognize the problem addressed by the presently claimed invention and certainly does not teach or suggest the specific solution to the problem as presently claimed.

In fact, the §102(b) analysis (pages 4 to 7 of the Office Action) makes no mention of finding in Samuelson a method involving the identification of active substances which affect binding. Moreover, the PTO disputes applicants' argument—that the limitation at issue establishes novelty over Samuelson—only because the limitation is in the claim preamble and, so, "has not been given patentable weight" (as discussed above). One can reasonably infer from this that the PTO appears to implicitly acknowledge that the limitation "to identify the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria"—now being recited in the body of the claims—establishes novelty, under §102(b), over the cited reference.

For the foregoing reasons, the "absence" from Samuelson of the limitation to identify the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria on all the present claims "negates anticipation" of any of the claims by the reference. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). Withdrawal of the rejection appears to be in order.

The obviousness rejections, under §103(a), are applied only to dependent claims 18, 19, 21, 27, and 28; neither Schneewind nor Strauss is relied on to supply deficiencies in Samuelson as applied to the claims in the §102(b) rejection, including independent claim 15. Neither Schneewind nor Strauss, taken alone or in combination, teaches or suggests the limitation to "identify the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria," as recited in the present claims. There is no objective evidence, of record, showing that one skilled in the art would have expected an advantageous result could be obtained by "identify[ing] the active substances that affect the covalent bonding of polypeptides to the surface of Gram-positive bacteria," i.e., as obtained in accordance with the presently claimed invention. Unexpected results can establish patentability over the prior art under §103(a), *In re Corkill*, 226 USPQ 1005 (Fed. Cir. 1985), which must be taken into consideration when comparing the claims against the prior art, whether or not they are recited in the claims. *In re Estes*, 164 USPQ 519 (CCPA). See, *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963).

Additionally, none of the cited references, taken alone or in combination, supports the limitation on the present claims to (emphasis added)

at least one reporter substance having a different enzymatic activity when not covalently bonded to the surface of the Gram-positive bacteria from that exhibited when it is covalently bonded to the surface of the Gram-positive bacteria,

i.e., to an effective method of identify[ing "the substances" that uses reporter substances having different enzymatic activities from one another depending on their bonding state.

For the foregoing reasons, since "the cited references do not support each limitation of [the present] claim[s]," maintaining either one of the rejections under §103(a) against the present claims would be "inadequate on its face." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). Accordingly the rejections under §103(a) are overcome and, so, withdrawal of the rejections appears to be in order.

Favorable action is requested.

Respectfully submitted,

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By

A handwritten signature in black ink, appearing to read "William E. Player", is written over a horizontal line.

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Date: October 9, 2007  
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